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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,340	10/25/2001	Scott J. Robinson	P-10076	3840

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MEDTRONIC, INC.
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EXAMINER

FIGUEROA, FELIX O

ART UNIT	PAPER NUMBER
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2833

DATE MAILED: 11/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/045,340

Applicant(s)

ROBINSON ET AL.

Examiner

Felix O. Figueroa

Art Unit

2833

NW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 40-79 is/are pending in the application.
- 4a) Of the above claim(s) 78 and 79 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 40-77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 October 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 27 June 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Claims 78 and 79 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the at least one electrical connector comprising a base metal having at least one plating material, as required by claims 13 and 24; and the housing having an opening and defining a first environment within the housing and the electrical contacts extending from the first environment within the housing to a second environment outside the housing, as required by claim 19-21, must be shown or the features canceled from the claims. No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

Claims 40, 45, 48, 54, 64, 66, 77 are objected to because of the following informalities:

In claim 40 line 7, "a" should be deleted after "to".

In claim 45 line 8, "structure" should be --structures--.

In claim 48 line 3, "sections" should be --section--.

In claim 54 lines 3-4, "the various" lacks antecedent basis.

In claim 64 line 2, "a second" should be --the second--.

In claim 66 line 2, "the electrical wires" lacks antecedent basis.

In claim 77 lines 2-3, "the apertures" lacks antecedent basis.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 59 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The scope of claim 59 is indefinite because there is an inconsistency within the claims. Claim 45, from which it depends, indicates that the subcombination, an apparatus, is being claimed. However, later claim 45 contains positive limitations directed toward the electrical wires, suggesting that applicant intends to claim the combination of the apparatus and the electrical wires. Applicant is required to clarify what subject matter the claims are intended to be drawn to and the language of the claim must be amended to be consistent with this intent.

The scope of claim 71 is indefinite because there is an inconsistency within the claims. Claim 60, from which it depends, indicates that the subcombination, an apparatus, is being claimed. However, later claim 71 contains positive limitations

directed toward an implantable medical device, suggesting that applicant intends to claim the combination of the apparatus and the implantable medical device. Applicant is required to clarify what subject matter the claims are intended to be drawn to and the language of the claim must be amended to be consistent with this intent.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 40, 41, 43 and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by Hirai et al. (US 6,059,601).

Hirai discloses an electrical connector comprising: a molded housing (8) of insulating material / plastic, having a plurality of contact pad-receiving interlocking structures; a stamped insert (Fig.9) having a plurality of contacts (3) secured to the molded housing; and a removable tab (11) attached to the stamped insert and removable by severing along a line of attachment / scribed line (12); and means for attaching (3b) an electrical wire to each contact.

Claims 45-48, 50-51, 53-54 and 56 are rejected under 35 U.S.C. 102(b) as being anticipated by Hirai et al. (US 6,059,601).

Hirai discloses an apparatus for connecting components comprising: at least one electrical connector (3,4) comprising a tab section (11); a housing (8) at least partially enclosing the at least one electrical connector; wherein the housing is molded into

sealing engagement with the electrical connector; wherein the tab section is capable of removal from the electrical connector after the housing is molded.

Regarding claim 46, Hirai discloses the apparatus being capable of providing electrical connection between a plurality of electrical components.

Regarding claims 47 and 48, Hirai discloses the at least one electrical connector comprising a series of electrical connectors (3) attached by the tab section prior to the molding of the housing around the connector; and the series of electrical connectors being capable of being segmented into discrete components after molding of the housing around the connector and removal of the tab section.

Regarding claims 50 and 51, Hirai discloses the housing comprising an insulating material / moldable plastic.

Regarding claim 53, Hirai discloses the at least one electrical connector providing an electrical passageway from a first contact surface (3a) to a second contact surface (3b).

Regarding claim 54, Hirai discloses the at least one electrical connector conducts electrical signals between a plurality of contact surfaces on each electrical connector, and wherein the housing provides isolation between the electrical connectors.

Regarding claim 56, Hirai discloses the at least one electrical connector comprising metal.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 49, 59-61, 63-65, 67, 70-71; 72-75 and 77 are rejected under 35 U.S.C.

103(a) as being unpatentable over Hirai.

Hirai discloses substantially the claimed invention except for the apparatus being a component of an implantable medical device. However, it would have been obvious to an ordinary worker in the art at the time the invention was made to use the structure of Hirai as a component of different electrical devices, such as an implantable medical device, to complete an electrical connection within the electrical device.

Regarding claim 60, Hirai discloses a feed-through arrangement comprising: a plurality of electrical contacts (3) for conducting electrical signals; a molded housing (8) comprising an electrically insulating material, the housing enclosing a portion of the plurality of electrical contacts, the housing being in sealing engagement therewith; the housing comprising a plurality of apertures (between members 13) capable of receiving electrical wires.

Regarding claims 63-65, Hirai also discloses the arrangement comprising a housing (see Fig.5) having an opening and defining a first environment within the housing and the electrical contacts extending from the first environment within the housing to a second environment outside the housing.

Claims 42, 52, 62 and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirai in view of Hawkins et al. (US 6,029,089).

Hirai discloses substantially the claimed invention except for the use of glass on the housing. Hawkins teaches the use of glass on a housing to provide visual confirmation of the electrical connection. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to form the housing comprising glass, as taught by Hawkins, to provide visual confirmation of the electrical connection.

Claims 55 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirai in view of Damaschke et al. (US 6,351,884).

Hirai discloses substantially the claimed invention except for the use of clamping connection instead of welded connection. Damaschke shows that a welded connection is an equivalent structure known in the art for a connection between a connector and an electrical wire. Therefore, because these two connection methods were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious the substitution of a clamping connection for a welded connection to securely maintain electrical continuity.

Claims 57-58, 68 and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirai in view of Saen et al. (US 4,870,227).

Hirai discloses substantially the claimed invention except for the electrical connector comprising a base metal and at least one plating material. Saen teaches the use of a connector (10) comprising a base metal and at least one plating material (nickel) to improve electrical connection and continuity. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to form

the connector of Hirai comprising a base metal and at least one plating material, as taught by Saen, to improve electrical connection and continuity.

Claims 60-61, 63-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Urushibata et al (US 5,057,650).

Urushibata discloses a feed-through arrangement comprising: a plurality of electrical contacts (13) for conducting electrical signals; a molded housing (12) comprising an electrically insulating material, the housing enclosing a portion of the plurality of electrical contacts, the housing being in sealing engagement therewith; the housing comprising a plurality of apertures (17) capable of receiving electrical wires (50). Urushibata discloses substantially the claimed invention except for the apparatus being a component of an implantable medical device. However, it would have been obvious to an ordinary worker in the art at the time the invention was made to use the structure of Urushibata as a component of different electrical devices, such as an implantable medical device, to complete an electrical connection within the electrical device.

Regarding claims 63-67, Urushibata also discloses the arrangement comprising a housing having an opening (from which 13 extend) and defining a first environment within the housing and the electrical contacts extending from the first environment within the housing to a second environment outside the housing; the plurality of apertures extending from the first environment within the housing to the second environment outside the housing.

Claim 62 is rejected under 35 U.S.C. 103(a) as being unpatentable over Urushibata in view of Hawkins et al.

Urushibata discloses substantially the claimed invention except for the use of glass on the housing. Hawkins teaches the use of glass on a housing to provide visual confirmation of the electrical connection. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to form the housing comprising glass, as taught by Hawkins, to provide visual confirmation of the electrical connection.

Claims 68 and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Urushibata in view of Saen et al.

Urushibata discloses substantially the claimed invention except for the electrical connector comprising a base metal and at least one plating material. Saen teaches the use of a connector (10) comprising a base metal and at least one plating material (nickel) to improve electrical connection and continuity. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to form the connector of Hirai comprising a base metal and at least one plating material, as taught by Saen, to improve electrical connection and continuity.

Response to Arguments

Applicant's arguments filed 6/27/03 have been fully considered but they are not persuasive.

In response to applicant's argument that Hawkins and Hirai are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's

endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Hawkins is related to medical devices; and Hirai addresses the a sealing or secure engagement between the pad and the housing.

Please note that recitations of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Felix O. Figueroa whose telephone number is (703) 308-0097. The examiner can normally be reached on Mon.-Fri., 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Bradley can be reached on (703) 308-2319. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.

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Effective May 1, 2003, the United States Patent and Trademark Office has a new Commissioner for Patents address. Correspondence in patent related matters must now be addressed to:

**Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450**

For additional information regarding the new address, see Correspondence with the United States Patent and Trademark Office, 68 Fed. Reg. 14332 (March 25, 2003).

ffr



**RENEE LUEBKE
PRIMARY EXAMINER**